



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit	: 2875	CUSTOMER NO. 35811
Examiner	: Jacob Y. Choi	
Serial No.	: 10/675,978	Docket No.: PMG-05-1321
Filed	: September 30, 2003	
Inventors	: Don Post, et al.	Confirmation No.: 6281
Title	: MASK WITH PATTERNED LIGHTING	
		Dated: April 17, 2007

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for review of the final rejection in the above application. This rejection is contained in the Office Action dated October 17, 2006.

This request is accompanied with a Notice of Appeal, along with the appropriate fee.

The outstanding Office Action sets a three-month response period. A request for a three-month extension of time, and the appropriate fee, also accompany this request. This extension resets the time period for response to April 17, 2007.

The basis for the requested review is stated in the attached sheets which start with the **Remarks** section begin on page 2 herein.

Charge any additional fee associated with this request, and credit any overpayment, to deposit account 50-2719.

REMARKS

The Claims as Pending

Claims 1-18 are pending in the application, with Claims 1, 6, 10, 13 and 16 being independent. These claims are listed in the Response to Second Office Action dated July 19, 2006.

The Objections and Rejections Under Consideration

Claims 1, 6, 13 and 16 stand objected as *informal* regarding their use of the term “adapted to”, citing *In re Hutchinson*, 69 USPQ 138 (CCPA 1946).

Claims 1-18 stand rejected under 35 USC 103(a) as obvious based on US 4,233,689 (Baron) and US 3,878,563 (Pulju).

Arguments on Appeal

The claims are definite and proper under 35 USC 112, para. 2. The mere use of the term “adapted to” does not render the identified unclear or “informal”. The preamble of the claims in question state the purpose of the claimed invention as being a device or mask for covering a person’s face and eyes. The body of the claims further defines the invention as including a masking layer of the type which covers a wearer’s face and which conforms to the facial features of the wearer. The person wearing the mask is not claimed. Rather, it is the structure of the mask which is being claimed. The terms of the claims in question define this structure with sufficient certainty and are therefore proper.

The mere use of the term “adapted for” is not dispositive. As stated in the MPEP, the determination on whether this clause is a proper claim limitation is dependant on the facts of each case. See *MPEP Sec. 2111.04*. Here, the claim language is sufficient to define the subject matter being claimed. As such, one of skill in the art would understand the claim and its intended scope.¹

¹ It is noted that the cited references include the same or similar language as that objected to in the present claims. In claim 1, Baron claims “...a transparent inner shell *adapted to fit over the wearer’s face....*” In claim 9, Baron defines the form of the mask as “...*defining a contoured [sic] generally corresponding to a human head....*” In Pulju claim 1, the mask is “*formed to cover substantially all portions of the face of the wearer that are exposed to the weather....*” Manifestly, the objected to language is definite with regard to – at least -- the subject matter of a mask.

The independent claims define a decorative mask and recite in various forms a pair of masking layers having activatable lamps positioned therebetween and eye holes defined in each masking layer, in registration with one another. The Examiner suggests that it would be obvious to combine the disclosure of Baron with the eye holes of Pulju to enhance visibility. It is respectfully submitted that one would not look to modify Baron's protective headgear for martial arts practice with Pulju's mask intended for protection from the cold to derive the decorative device as presently claimed. There is no suggestion in the prior art of record to make the combination proposed. It is not proper to reconstruct the claims by randomly selecting features from various references, without some basis in the references themselves to make the modification.

As detailed in the Response to Second Office Action (submitted July 19, 2006), Baron discloses protective headgear for martial arts training having an inner transparent shell and a pair of transparent, flexible sheets sealed to the inner shell, forming a shock-absorbing air chamber about the inner shell. A plurality of sensors and lights are provided within the chamber that react to a striking blow. The protective headgear surrounding the internal sensors and the eyes are constructed of materials which will protect the wearer, as well as the training partner, during combat. (See detail in Response, pages 6-8.)

Pulju discloses a mask for protection from cold temperatures during activities such as snowmobiling. The mask includes a body having openings defined therein to accommodate the eyes, nose and mouth. A flexible skirt covers the nose opening and mouth opening. Only the lower portion of the Pulju mask has multiple layers. The eye openings are defined in a single layer and there is no registration between openings for the mouth and/or nose with the associated second layer.

The Office Action asserts that Baron could be modified to include the eye holes of Pulju. However, such a modification is not suggested and would make Baron unsuitable for its intended purpose of martial arts training. Baron specifically covers the eye areas with (transparent) protective layers to prevent injury during use. Manifestly, there is no suggestion in Baron to make the proposed modification. Further, Pulju does not place two layers adjacent the eyes, nor do any of its layers include openings in registration.

The structure of a screen material over the eye openings in the two layers is particularly recited in Claims 6 and 13. These claims specify that the screen material permits visibility therethrough and creates a shadow that resists viewing of the wearer's face and eyes positioned

behind the screen. Claims 17 and 18 further specifically recite that the screen is a woven fabric having sufficient openings to permit the wearer to see out.² The Office Action asserts that the Baron structure, modified with eye openings in Pulju, could be further modified with a screen, such as the screen covering the mouth in Baron. Again, there is no suggestion for this further modification. Baron discloses a clear structure that covers and protects the eyes. Pulju discloses nothing covering the eye openings. Nothing indicates that the mouth element in Baron could or should be moved to an alternate position. Moreover, to use the mouth structures in Baron as eye covers, such would require substantial physical reconstruction in order to be useful. Again, the cited references fail to suggest the proposed modification or disclose the particularities of the claims.

Claim 10, 13 and 16 also recite that the outer masking layer permits viewing the lights when they are activated, but hides the lamp structures and electrical connections. Claims 10 and 13 define this outer masking layer as being made of a translucent material. The inner layer in the claims is defined as opaque. Baron requires that both layers be transparent. Baron states that the lamp structures must be visible so that the wearer and the training partner can see the particular light which is activated and which defines the position of the blow to the mask. Nothing within Pulju supplements the disclosure of Baron to provide a translucent outer layer that hides the lamp circuitry and structure, while permitting viewing of a lighted lamp. Also, to place an opaque mask layer, such as that in Pulju, on Baron would be contrary to its teaching, negating any form of suggestion for this modification. There is nothing in Pulju to motivate one to modify Baron with opaque components.

In response to the arguments in favor of patentability, the Office Action emphasizes that the rejection is based on obviousness. However, where the references fail to disclose one or more portions of the claimed structure, the differences render the claims nonobvious. For example, neither Baron nor Pulju disclose two layers with aligned eye sockets in the layers. The overlapping portions in Baron do not include eye openings. The overlapping portions in Pulju are not positioned adjacent the eyes. Moreover, the overlapping portions in Pulju cover the mouth and nose openings and there is no alignment or registration between openings within the two layers.

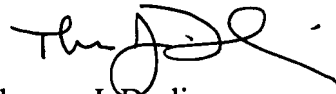
² As explained in paragraph 23 of the Specification, this screen, in combination with the darkness behind the mask, creates a shadow of the eyes to resist viewing of the eyes when the mask is worn.

Further, the Office Action argues against the use of hindsight reconstruction by referencing *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). However, in addition to the teaching of the prior art, one must look at whether the references teach away from the claimed invention. See, e.g., *In re Fulton*, 391 F.3d 1195, 1199-2000 (Fed. Cir. 2004). Baron restricts what may be considered motivation to combine references by its very nature, being directed to a protective covering, which must protect the eyes from finger jabs or similar blows. To modify Baron to the point where it no longer meets its stated purpose is an improper basis for asserting obviousness.

It is respectfully submitted that there is no suggestion or disclosure that would result in the modification of Baron with Pulju to produce the specific combination within pending Claims 1-18.

For the above reasons, it is respectfully submitted that the claims are in condition for allowance.

Respectfully submitted,



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